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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHER LEE BERG,
TODD WILLIAM SHARRATT, and STEVEN MARK LEVAHN

Appeal 2009-008803
Application 10/623,179
Technology Center 3700

Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and KEN B.
BARRETT, *Administrative Patent Judges*.

BARRETT, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Christopher Lee Berg et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 9-19. We have jurisdiction under 35 U.S.C. § 6(b). We AFFIRM-IN-PART.

THE INVENTION

Claims 9 and 19, reproduced below, are representative of the subject matter on appeal.

9. An apparatus for use in performing a knee-joint replacement surgery on a surgical table, the surgery involving a tibia and femur joined at a knee joint, the apparatus comprising:

a retractor support rigidly mounted to the surgical table;
and

a plurality of retractors attached to the retractor support and each having a retractor blade for engaging skin and flesh layers proximate the knee-joint wherein at least one of the retractors has a flexible portion that flexes sufficiently so that the tibia may be moved during the surgery without having to re-engage the retractors with the flesh and skin layers or to reattach the retractors to the retractor support or adjust the retractor support.

19. An apparatus for use in securing a lower leg in knee surgery on a surgical table wherein a knee is disposed in an elevated position, the apparatus comprising:

a retractor support mounted to the surgical table wherein the retractor support includes first and second support arms that are extendable along opposite sides of the knee, each support arm having distal end portions; and

a flexible strap extending between the distal end portions of the support arms for engaging the lower leg such that a generally downward force is applied against the lower leg to retain the lower leg in position.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Whitt	US 4,373,709	Feb. 15, 1983
Grieshaber	US 4,813,401	Mar. 21, 1989
Fowler	US 5,964,698	Oct. 12, 1999
(“Fowler ‘698”)		
Fowler, Jr.	US 6,190,312 B1	Feb. 20, 2001
(“Fowler, Jr. ‘312”)		

The following Examiner’s rejections are before us for review:

1. Claim 19 is rejected under 35 U.S.C. § 102(b) as being anticipated by Whitt;
2. Claims 9-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fowler, Jr. ‘312, Fowler ‘698, and Grieshaber; and
3. Claims 17 and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Whitt.

OPINION

The rejection of claim 19 as being anticipated by Whitt

Independent claim 19 recites an apparatus for use in securing a lower leg during knee surgery, the apparatus comprising: 1) a retractor support having “first and second support arms that are extendable along opposite sides of the knee,” and 2) a flexible strap extending between the support arms “for engaging the lower leg such that a generally downward force is applied against the lower leg to retain the lower leg in position.” As such, Appellants have used functional language to define the apparatus, and therefore an anticipatory prior art device must be configured so as to be

capable of performing the recited functions. *See In re Swinehart*, 439 F.2d 210, 213 (CCPA 1971).

We agree with the Examiner that Whitt's limb holder is somewhat adjustable. *See* Ans. 7 (citing Whitt, col. 1, ll. 5-22, 37-56); *see also* Whitt, col. 2, ll. 27-31 (cited at Ans. 4). Although Whitt's device is depicted in Figure 1 as supporting a thigh (but not the lower leg portion as the Examiner seems to have found, Ans. 7), we also recognize that the device is capable of being used as a support for other limbs. However, we agree with Appellants (App. Br.² 13; Reply Br. 6) that Whitt's limb holder does not appear to be configured so as to have arms extendable along opposite sides of the knee while also having a strap engaging the lower leg such that the lower leg is retained by downward force. *See* Whitt, fig. 1. We do not sustain the rejection of claim 19 as anticipated by Whitt.

The rejection of claims 9-16 as being unpatentable over Fowler, Jr. '312, Fowler '698, and Grieshaber

Appellants argue the rejected claims as a group. App. Br. 8-11 (presenting arguments regarding independent claim 9 and asserting that claims 10-16 are allowable due to their dependency from claim 9). We select claim 9 as the representative claim, and claims 10-16 stand or fall with claim 9. 37 C.F.R. § 41.37(c)(1)(vii).

Claim 9 recites "[a]n apparatus for use in performing a knee-joint replacement surgery" having a retractor support mounted to a surgical table

² We refer to the Appeal Brief entitled "Resubmitted Brief for Appellant," filed Sept. 6, 2006, which is the Appeal Brief identified in the Docketing Notice and the brief to which the Examiner responded in the Answer (Ans. 1).

and a plurality of retractors with each having a retractor blade, at least one of which “has a flexible portion that flexes sufficiently so that the tibia may be moved during the surgery without having to re-engage the retractors with the flesh and skin layers or to reattach the retractors to the retractor support or adjust the retractor support.” Appellants explain that it is the flexible portion that allows the bones to be moved during surgery without repositioning the retractor or support. Spec. 4: 24 – 5: 14. Appellants disclose “a retractor blade 40 attached to a flexible connector 42 such as plastic cord,” and further state that the flexible connector may be elastic or made of resilient material. *Id.* at 4: 20-22, 5:9-11.

The Examiner found that Fowler, Jr. ‘312 discloses the claimed invention – including a conventional retractor frame, or “retractor support,” and a retractor attached to an elastic member – with the exception of a retractor having a blade and a retractor support being mounted to a surgical table. Ans. 4. The Examiner further found that Fowler ‘698 evidences that retractors having paddles or “blades” attached to elastic members are well known, and that Grieshaber teaches supporting a conventional retractor frame on a surgical table in order to maintain the retractor frame at a desired elevation above the incision site. *Id.* at 4-5, 6-7. Appellants do not appear to contest any of these fact findings (App. Br. 9-11; Reply Br. 4-5) and we adopt them as our own. We agree with the Examiner’s conclusion (Ans. 4-5, 7) that the references’ combined teachings render obvious the subject matter of Appellants’ claim 9. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.”)

Appellants argue that “[t]he Examiner’s Answer provided no motivation, teach [sic, teaching] or suggestion in any of the cited patents that would lead to the combination of references.” Reply Br. 4; *see also* App. Br. 9-11 (arguing that there is a lack of a clear and particular teaching, suggestion or motivation to combine). The Supreme Court has rejected such a rigid requirement for an obviousness analysis. *See KSR Int’l Co.*, 550 U.S. at 418-19. The Court noted that an obviousness analysis “need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 418. We determine that the Examiner’s conclusion of obviousness is supported by adequate articulated reasoning with rational underpinning. *See* Ans. 5, 6-7.

Appellants argue that each of the references lacks a particular disclosure and therefore the Examiner must have utilized improper hindsight. Reply Br. 4-5; *see also* App. Br. 10-11 (addressing Fowler, Jr. ‘312 and Grieshaber individually). This argument is not persuasive as “[n]on-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

Appellants argue that “[n]either reference addresses the purpose of the claimed invention where the tibia is moveable during a knee-joint replacement surgery without reengaging the retractors with the flesh or reattaching the retractors to the support.” App. Br. 11. This argument is unavailing as “neither the particular motivation nor the avowed purpose of the [Appellants] controls” in an obviousness analysis. *KSR Int’l Co.*, 550

U.S. at 419. We acknowledge that claim 9 recites the intended use for the apparatus and that the body of the claim contains functional language that defines the flexible retractor portion in terms of the intended knee surgery. The Examiner reasonably found that the device of the references' combined teachings "is fully capable of performing the functions recited in claim 9." Ans. 7. Appellants offer no persuasive argument or evidence as to why the Examiner's proposed combination does not result in an apparatus capable of being used in knee-joint replacement surgery or why one of ordinary skill would fail to see that apparatus's applicability to knee surgery.

The rejection of claim 9 and its dependent claims 10-16 under § 103 is affirmed.

The rejection of claims 17 and 18 as being unpatentable over Whitt

Claims 17 and 18 recite a method of holding down a lower leg involving the steps of positioning a retractor having arms that extend along opposite sides of the knee, and positioning a flexible strap such that it engages the lower leg with a downward force. The Examiner maintains that it would have been obvious to use Whitt's "limb holder 10 to restrain the lower leg or 'tibia'" Ans. 5, *see also id.* at 8-9. The Examiner's conclusion of obviousness appears to be based on the underlying finding, with which we disagree, that Whitt's device anticipates the device of claim 19. *See* Ans. 5 (citing to the Examiner's discussion of claim 19); *see also* our discussion above regarding the anticipation rejection. It seems that, if Whitt's limb holder were positioned such that the strap engages the tibia, the device's "arms" would extend along opposite sides of the tibia (the lower leg) not the knee. The Examiner has not adequately articulated why the

claimed method including both positioning steps would have been obvious. We do not sustain the rejection of claims 17 and 18 as unpatentable over Whitt.

DECISION

The decision of the Examiner to reject claims 17-19 is reversed. The decision of the Examiner to reject claims 9-16 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

mls

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